REMARKS

Claims 1-8 are pending in the application. Claim 1 has been amended herein. The abstract has been amended to remove reference numerals as requested by the Examiner, and the specification has been amended to include cross-reference information. Favorable reconsideration of the application, as amended, is respectfully requested.

I. REJECTION OF CLAIM 1 UNDER 35 USC §101

Claim 8 stands rejected under 35 USC §101as being directed to non-statutory subject matter.

Applicants have amended claim 8 in accordance with USPTO recommendation to recite that the program is stored on a non-transitory machine readable medium. Support for such amendment may be found, for example, at page 12, lines 28-31 of the present application.

Accordingly, applicants respectfully request withdrawal of the rejection.

II. REJECTION OF CLAIMS 1, 6 AND 8 UNDER 35 USC §103(a)

Claims 1, 6 and 8 stand rejected under 35 USC §103(a) based on *Williams* in view of *Demsey et al.* Applicants respectfully traverse the rejection for at least the following reasons.

Regarding claims 1, 6 and 8, the Examiner concedes that primary reference *Williams* fails to disclose the recited steps of (b), (d) and (f). However, the Examiner submits that *Demsey et al.* teaches such features and that it would have been obvious to combine such features with *Williams* so as to result in the claimed invention. Applicants respectfully submit that Demsey does not make up for the deficiencies of *Williams* and that such a combination would not have been obvious for at least the following reasons.

a.   *Williams and Demsey et al. Not Obvious to Combine*

Applicants respectfully submit that the Examiner has not provided any reasoning as to why one having ordinary skill in the art would have found it obvious to combine the teachings of *Williams* and *Demsey et al.* in the proposed manner. The Examiner merely states that:

> *[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the reading, updating and storing of metadata as taught by Demsey with that of Williams in order to execute the requested method associated with the manage program using the physical addresses. (OA, pg. 5).*

However, the inventions described in *Williams* and *Demsey et al.* are quite different. *Williams* is directed to a write-once, read-many optical data storage system which includes an optical disk to which data is written such that a host data system having access to the optical data storage system is enabled to access any one of a predetermined number of logical addresses for storing data at a selected logical address whether or not data had previously been stored at that logical address thereby providing a pseudo-erasable and rewritable write-once optical disk memory device. (See, e.g., Abstract).

Demsey et al. in contrast is not at all concerned with write-once disks and the associated operations to use logical addresses to treat the write-once disk as a read/write disk. Rather, *Demsey et al.* seeks to provide a virtual machine environment operating on portable devices with limited resources. In fact, upon review of the disclosure of *Demsey et al.*, no mention at all is found of using logical addresses or write-once disks.

Thus, the teachings of *Williams* and *Demsey et al.* are not related and do not share a similar problem to be solved. An ordinarily skilled artisan would not have recognized an apparent reason to combine the teachings and would not have known to do so, as there is no problem. The Examiner's own explanation as to why it would have been obvious to combine the references fails to explain why the ordinarily skilled artisan would combine the references other than "to executed the requested method associated

with the managed problem". This is akin to saying that it would have been obvious to combine certain features of *Demsey et al.* with those of *Williams* simply because *Williams* does not disclose the certain features of *Demsey et al.*

b. Demsey is Non-Analogous Art

While the scope of analogous art may be construed broadly to include a reference in a field different from that of applicant's endeavor, such is in the case when the reference is pertinent to the problem that the inventor was trying to solve. *Wyers v. Master Lock Co.*, No. 2009-1412, --F.3d--, 2010 WL 2901839 (Fed. Cir. July 22, 2010).

As noted above, however, the invention of *Demsey et al.* is in a different field, not at all confronted with the restrictions of a write-once disk and as such deals with very different problems. As the initial premise and principles in *Demsey et al.* vary substantially from that of *Williams* and the present invention, the teachings of *Demsey et al.* cannot be considered applicable. *Demsey et al.* describes that the metadata map is written in non-volatile memory such as flash memory and can be cleared and overwritten. See, e.g., [0044] of *Demsey et al.* The problem addressed by *Demsey et al.* is clearly a property of non-volatile memories which are exclusive of write-once discs as in the present invention.

c. Combination of Williams and Demsey et al. Still Deficient

Even assuming, arguendo, the disclosures of *Williams* and *Demsey et al.* were properly combinable, the references still do not teach each and every feature of the claimed invention. In particular, neither of the references has been found to teach step (f) of instructing the drive apparatus to write at least a part of the updated metadata to the location from which the metadata is read in step (b) in the write-once disc.

The Examiner has admitted that such feature is absent in *Williams.* However, the Examiner still has not shown which portion of *Demsey et al.* describes such feature. While *Demsey et al.* teaches that metadata stored in memory may be stored in memory and updated (see, e.g., [0042]), it does not teach of writing the metadata to the same place.

Therefore, the combination of *Williams* and *Demsey et al.* still fail to teach or suggest at least step (f).

For at least the above reasons, applicants respectfully submit that the rejection of claims 1, 6 and 8 is improper and should be withdrawn.

III. REJECTION OF CLAIMS 2-5 UNDER 35 USC §103(a)

Claims 2-5 stand rejected under 35 USC §103(a) based on *Williams* in view of *Demsey et al.* Applicants respectfully traverse the rejection for at least the following reasons.

Claims 2-5 each depend from claim 1 and are therefore patentably distinguishable for at least the same reasons discussed above. Withdrawal of the rejection is respectfully requested.

IV. REJECTION OF CLAIMS 1, 6, 7 AND 8 UNDER OBVIOUSNESS-TYPE DOUBLE PATENTING

Claims 1, 6 and 8 stand provisionally rejected based on obviousness-type double patenting in view of *Buban et al.* (US App. No. 10/597,875).

In the interest of facilitating favorable prosecution, applicants submit herewith a Terminal Disclaimer. Accordingly, applicants respectfully request withdrawal of the rejection.

V. CONCLUSION

Accordingly, all claims 1-8 are believed to be allowable and the application is believed to be in condition for allowance. A prompt action to such end is earnestly solicited.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should a petition for an extension of time be necessary for the timely reply to the outstanding Office Action (or if such a petition has been made and an additional extension is necessary), petition is hereby made and the Commissioner is authorized to charge any fees (including additional claim fees) to Deposit Account No. 18-0988.

Respectfully submitted,

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